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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,742	10/13/1999	NEWTON B. WHITE, JR.	GRENP001NP	4358

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/381,742

Applicant(s)

WHITE, JR., NEWTON B.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-123, 129, 137-140, 163-166 and 168-208 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 65-123, 129, 137-140, 163-166, 168, 182, 183, 185-190, 196 and 204-208 is/are allowed.
- 6) ☒ Claim(s) 169- 181, 184, 191-195, 200-202 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-64, 124-128, 130-136, 141-152, 159-162 and 167 are withdrawn for consideration based on the Applicant's election with traverse.
2. Claims 65-123, 129, 137-140, 163-166, 168 and 169-208 are presented for examination.

Claim Rejections - 35 U.S.C. § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 196 is directed to non-statutory subject matter. Claim 196 recites a data stream. However, the data does not impact functionality to the data stream as claimed. As such, the claimed invention recites non-functional descriptive material, i.e. mere data. The allowance of such a claim would exalt form over substance. For the above mentioned reason, claim 196 is deemed non-statutory.

Claims 169-171, 173-177, 179, 182-183, 184-208 15 are non-statutory. Applicant has not given any process or any structural means for carrying out the invention. Applicant's invention is not implemented with any specific automated computer apparatus. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process. the claims are

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not in the "technological" or "useful" arts, and the claims do not affect or define the technology. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 177 and 178 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims call for a digital signature but then it recites that it is secured without requiring the digital signature. It is confusing as to if the digital signature is claimed or not. For purpose of examination, it will be examined as if the digital signature is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 169-176, 179, 181 and 184 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams et al. (3,573,747 hereinafter Adams).

With respect to claims 169-176, 179, Adams teaches a method for

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operating an offer matching or information system for a traded item (abstract).

Associating a first offer to buy or to sell the traded item with a first identifier (col. 10, lines 1-15 and col. 12, lines 1-9); receiving request for information where the request includes the first identifier (col. 10, lines 1-15 and col. 12, lines 1-9); the request is received in a manner that does not imply that that the request is from a person entitled to receive nonpublic information concerning the first offer (col. 12, lines 1-9); and in response to the request, sending a reply comprising a data item that concerns the first offer (col. 10, lines 1-36 and col. 12, lines 1-12).

Claims 170-171 further recites well known execution information and process of an offer.

Claim 174 further recites that the disclosee possesses information which discloses that a first related person satisfies a first condition and that first related person is acting as an agent for the first offer. Adams teaches that the disclosee (investor) is the one entering the information in the system and since it is obvious and well known for systems to have agents acting on behalf of the investors then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the disclosee having information about the agent because such a modification would allow the investor or disclosee to recognize the agent based on certain conditions and therefore he or she would know that the agent is acting on his or her trade.

With respect to claims 179 and 181, Adams further teaches publishing the information (col. 12, lines 51-62).

With respect to claim 184, the claim further recite and Adams further teaches the

offer matching system monitoring the trade (col. 2, lines 73-, col. 3, lines 1-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 180, 191-195, 197-198, 200-202 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams.

With respect to claim 180, further recites well known execution information and process of an offer.

With respect to claims 191, 192, 194, 195, 197-199, 201-202, Adams teaches receiving from a first participant a first description of the first offer (i.e. subscriber A describes the first offer)(col. 10, lines 1-36); associating the first offer with a first identifier, the first identifier not associated with any offer other than the first offer (col. 10, lines 1-15 and col. 12, lines 1-9); receiving from a second participant a description of a second offer (i.e. subscriber B sends an offer to sell(col. 10, lines 1-15); the offer matching system's executing the first offer at least in part against the second offer in accordance with a set of rules that govern the operation of the offer matching system (col. 10, lines 1-53); publishing a first data packet that comprises the first identifier and a first data item, the first data item concerning the first offer (col. 12, lines 51-62).

With respect to if the description did not disclose the first identifier, sending the first identifier to the first participant in a manner that discloses to the first participant that the first identifier is associated with the first offer. The participants have to identify the offers by reference numbers (col. 12, lines 4-13) therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included sending the first identifier to the participant if the participant didn't disclose the identifier associated with the first offer because such a modification would allow for correct identification of the offers.

With respect to claim 193, since the first data item is responsive to the information requested by the disclosee on changes and modifications and changes to the offer and since the second offer is to be matched with the first offer to find out if a offer can be executed then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included selecting a predetermined relationship between the first data item and the second offer to obtain the above mentioned advantages.

Claim 200 further recites that the first data item specifies a price at which the first offer was executed against the second offer. Official notice is taken that is old and well known to publish the execution certain items, for example when a home is sold the price and the location is published and it becomes public information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included specifying a price at which the first offer was executed against the second offer because such a modification

would provide the public with an idea of the sales prices of the items.

With respect to claim 203, in addition to the rejections addressed, Adams teaches storing in the offer matching system a first association among a first participant and a first monitor (col. 2, lines 73-, col. 3, lines 1-10).

7. Claims 177-178, are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Hauser et al. (WO 97/25801 hereinafter Hauser).

With respect to claims 177-178 in addition to the limitations previously addressed above in the rejections to claims 169, 172-173 and 175-176, the claims further recite that the reply comprises a digital signature. On the other hand, Hauser teaches secure anonymous information exchange in a network, and the data sets are digitally signed, as far as necessary to provide proof of the partner. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a digital signature in the reply as taught in Hauser because such a modification would provide the above mentioned advantage.

Allowable Subject Matter

7. **The following claims are allowable.**

With respect to claims 76-81 and 163-166, the Examiner asserts that the first data item concerns the first offer, and before receiving the first data item, the

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first disclosee does not possess information which discloses that the first data item concerns the first offer, whereby the first discloser, which already possesses information which discloses that the first related person satisfies the first condition, gains possession of information which discloses that the first data item concerns the first offer, is not taught in the prior art of record.

With respect to claims 65-75, 82-87, 101-117, 163-165 and 168, the Examiner asserts that at a time when the first offer was capable of execution, the third offer executed in whole or in part against a fourth offer, wherein the fourth offer is not the first offer, and that at a first time when the first offer was capable of execution: the third offer executed in whole or in part against a fifth offer, wherein the fifth offer is not the first offer, and the first offer could have executed in whole or in part against the fifth offer in accordance with the set of rules if the offer matching system had not possessed information concerning any other offers for a same side as the first offer; and in response to the first request, and without the offer matching system's determining that the first request is from a person entitled to receive confidential information concerning the third offer, in combination with the other limitations is not taught in the prior art of record.

With respect to claims 94-100, the Examiner asserts that the second data packet is published in a manner that permits the first disclosee to receive it regardless of whether the first disclosee has a right to receive confidential information concerning the first offer, and prior to publication of the second data

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packet, the first disclosee does not possess information which discloses that the second data item concerns the first offer; the first disclosee's receiving the second data packet and detecting that the second data packet includes the first identifier, whereby the first disclosee, which already possesses information which discloses that the first related person satisfies the first condition, gains possession of information which discloses that the first data item concerns the first offer, in combination with the other limitations is not taught in the prior art of record.

With respect to claims 88-93, 118-123, the Examiner asserts that the first data item concerns the first offer, and the monitor does not already possess information which discloses that the first data item concerns an offer that satisfies the first condition, whereby the first monitor gains information which discloses that the first data item concerns an offer that satisfies the first condition; and attempting to avoid publicly disclosing that the first data item concerns an offer that satisfies the first condition, is not taught in the prior art of record.

With respect to claims 129 and 137, the Examiner asserts that calculation of the second data item depends upon a third data item that is not obtained from the offer matching system, in combination with the other limitations is not taught in the prior art of record.

With respect to claim 138-140, the Examiner asserts that after receiving the

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first description but before the offer matching system determines that the future time has occurred, executing the second offer at least in part against the third offer, wherein, if the offer matching system had already determined that the future time had occurred, the second offer would have had a lower execution priority than the first offer and the offer matching system would not have executed the second offer even in part against the third offer, is not taught in the prior art of record.

With respect to claims 182-183, the Examiner asserts that the first disclosee's detecting that the data packet includes the first identifier, whereby the first disclosee gains possession of information which discloses that the data item concerns the first offer.

With respect to claims 185-186 and 204-208, the Examiner asserts that the system determining a minimum price that is the lowest price at which the sell offer may be executed against the buy offer is not taught in the prior art of record.

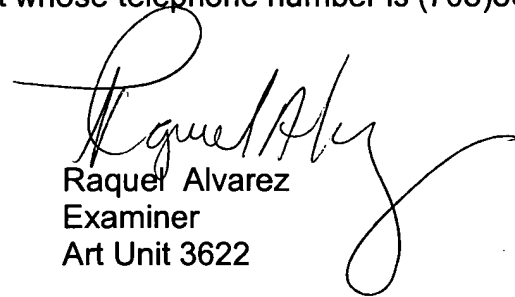
With respect to claims 187-190, 196, the examiner asserts that the offer matching system executing the first offer at least in part against the second offer in accordance with a set of rules that govern the operation of the offer matching system is not taught in the prior art of record.

Point of contact

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Raquel Alvarez
Examiner
Art Unit 3622

R.A.
April 4, 2003